

Application No. 10/605,858
Docket No. 132855
Amendment dated June 2, 2006
Reply to Office Action of February 2, 2006

REMARKS

In the Office Action, the Examiner reviewed claims 1-7, 9-26, and 28-30 of the above-identified US Patent Application, with the result that all of the claims were rejected under either 35 USC §102 or §103 in view of U.S. Patent No. 3,900,613 to Galmiche et al. (Galmiche).

In response, Applicants have amended the claims as set forth above. More particularly, independent claims 1 and 21 have been amended to incorporate the limitations of their respective dependent claims 2 and 22 in their entirety. As such, the above amendments do not present new matter and strictly comply with 37 CFR §1.116(a) as being limited to reducing and simplifying the issues remaining in the examination of Applicants' application, namely, the cancellation of dependent claims and incorporation of their subject matter into their respective parent claims. Consequently, the above amendments do not raise new issues that would require further consideration and/or search by the Examiner, and place the claims in better condition for appeal.¹

¹ MPEP §714.13 instructs:

It should be kept in mind that applicant cannot, as a matter of right, amend

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Applicants respectfully request reconsideration of the rejections for the following reasons.

In the Office Action, the Examiner persuasively argued that

surface active agents reduce surface tension between a liquid and a solid; this property is what confers the thixotropic properties of the mixture. . . . [A] surface active agent allows easier spreading of a liquid. Therefore, the surface active agent, such as oleic acid, responsible for conferring thixotropic properties in Galmiche's invention has a property opposite of acting as an adhesive or binder (Original emphasis.)

Page 3 of the Office Action.

The Examiner also persuasively argued that "ammonium chloride is slightly soluble in alcohol" (page 2 of the Office Action).

any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely *cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner*, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection. (Emphasis added.)

MPEP 714.13 further instructs: "The refusal to enter the proposed [Rule 116] amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether *the issues on appeal are simplified*." (Emphasis added.)

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The Examiner's position is that the surface active agent cannot act as a binder for Galmiche's cement, and therefore only a slight amount of dissolved ammonium chloride present in Galmiche's cement is the only ingredient in Galmiche's cement capable of acting as a binder. The surface tension-reducing affect of the surface active agent clearly dominates the fluid properties of Galmiche's cement because, as the Examiner has argued, the surface active agent controls the thixotropic property of Galmiche's cement. Finally, because the surface active agent's affect on the cement is, as the Examiner has argued, "opposite . . . an adhesive or binder," it undoubtedly counteracts any slight adhesive effect of the slightly dissolved ammonium chloride. Therefore, Galmiche's cement cannot be an adhesive mixture, contrary to Applicants' claimed process. Instead, based on the Examiner's position that surface active agents "caus[e] spreading," Galmiche's cement flows and spreads on a surface to which it applies, the very opposite of adhesion.

Also contrary to Applicants' claimed invention, Galmiche does not disclose or suggest that Galmiche's cement is ever a solid capable of adhering to a surface, as now required by all three independent claims. Instead, Galmiche uses the terms "cement" and "paste" interchangeably.

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In view of the above, Applicants believe that the claims define patentable novelty over Galmiche, and respectfully request withdrawal of the rejections.

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

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Attachment: Fee Transmittal form